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PRACTICE NOTES

IN

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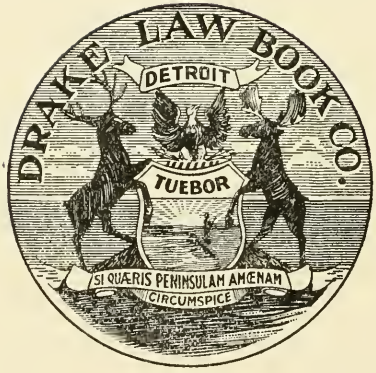
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PATENT CITATOR

WITH

PRACTICE NOTES

IN

APPEAL CASES

BY

ELLIOTT J. STODDARD

(DETROIT BAR)

DETROIT, MICHIGAN

DRAKE LAW BOOK COMPANY

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PREFACE

The Court of Appeals of the District of Columbia seems to be attracting a greater and greater degree of confidence. Appeals to it in patent matters are more prevalent than formerly, and the stricture, that it is a mere instrument for putting a seal upon the errors of an over-burdened Patent Office, is not so frequently heard. Those interested in patent property are indebted to it for settling a number of difficult questions of law and practice upon what seems to be correct and permanent grounds. A sentiment of gratitude and courtesy imposes upon those practicing before it the pleasant obligation of facilitating its labors as much as possible. It is hoped that these notes, mainly made for my own use, may assist to this end in some slight degree.

ELLIOTT J. STODDARD.

Detroit, Mich., March 15, 1909.

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PATENT PRACTICE NOTES

IN

APPEAL CASES

Court Rules

No. VIII.

COURT DECISIONS MUST BE CITED IN BRIEFS

4. Whenever a decision of the Court, that has been published in the official reports of the Court, shall be cited in a brief, the reference shall include the volume and page of the reports wherein the same has been published.

No. XXI.

APPEALS FROM THE COMMISSIONER OF PATENTS

1. All certified copies of papers and evidence on appeal from the decision of the Commissioner of Patents, authorized by section 9 of the act of Congress approved February 9, 1893, shall be received by the clerk of this Court, and the cases, by titling and numbering as they appear on the record in the Patent Office, shall be placed on a separate docket from the docket of the cases brought into this Court by appeal from the Supreme Court of the District of Columbia, to be designated as the "Patent Appeal Docket;" and upon filing such copies the party appellant shall deposit with the clerk, or secure to be paid as demanded, an amount of money sufficient to cover all legal costs and expenses of said appeal; and upon failure to do so his appeal shall be dismissed. The clerk shall, under this titling of the case on the docket, make brief entries of all papers filed and of all proceedings had in the case.

2. The appellant, upon complying with the preceding section of this rule, shall file in the case a petition addressed to the Court in which he shall briefly set forth and show that he has complied with the requirements of sections 4912 and 4913 of the Revised Statutes of the United States to entitle him to an appeal, and praying that his appeal may be heard upon and for the reasons assigned therefor to the Commissioner; and said appeal shall be taken within forty days, exclusive of Sundays and legal holidays, from the date of the ruling or order appealed from and not

afterwards. If the petition for an appeal and the certified copies of papers and evidence on appeal mentioned in this and the preceding section of this rule shall not be filed and the case fully docketed from the day upon which notice of appeal is given to the Commissioner of Patents, the Commissioner, upon such facts being brought to his attention by motion of the appellee, duly served upon the appellant or his attorney, may take such further proceedings in the case as may be necessary to dispose of the same, as though no notice of appeal had ever been given. That this addition to said Rule 21 shall not go into effect and operation until and from the first Monday of December next; and that a copy of said Rule 21, as thus amended, be furnished by the clerk of this Court to the Commissioner of Patents.

3. The clerk shall provide a minute book of his office, in which he shall record every order, rule, judgment, or decree of the Court in each case, in the order of time in which said proceedings shall occur; and of this book the index shall be so kept as to show the name of the party applying for the patent, the invention by subject matter or name, and, in the cases of interference, the name of the party with whose pending application or unexpired patent the subsequent application is supposed to interfere.

4. The cases on this docket shall be called for argument on the second Tuesday of January, March, May and November in each year, and the cases shall be called in regular order as they may stand on the docket. A copy of these rules shall be furnished to the Commissioner of Patents; and it shall be the duty of the clerk of this Court to give special notice to the said Commissioner at least fifteen days immediately preceding the times thus respectively fixed for the hearing of said cases; the said notice to name the place of the sitting of the Court, the titling of the cases on the docket of this Court, the respective numbers thereof, and the number of each case as it appears of record in the Patent Office; and thereupon the Commissioner shall give notice to the parties interested or concerned by notice addressed to them severally by mail.

5. The clerk shall furnish to any applicant a copy of any paper in any of said appeals on payment of the legal fees therefor.

6. The appeals from the Commissioner of Patents shall be subject to all the rules of this Court provided for other cases therein, except where such rules, from the nature of the case, or by reason of special provisions inconsistent therewith, are not applicable.

No. XXII.

OPINIONS OF LOWER COURT AND COMMISSIONER OF PATENTS MADE PART OF RECORD

Whenever the judgment, decree, or order appealed from is based upon

or has reference to a written opinion filed in the case by the court below, such opinion shall constitute a part of the transcript to be sent to this Court; and such opinion, and also the written reasons or grounds assigned by the Commissioner of Patents in appeals from the Patent Office, shall be printed as part of the record to be printed under Rule 6.

No. XXVI.

SUNDAYS AND LEGAL HOLIDAYS EXCLUDED

That wherever days are mentioned in the foregoing rules as limitation of time they shall be construed to exclude Sundays and legal holidays.

Instructions to Appellants

The act of Congress creating the Court of Appeals of the District of Columbia, approved February 9, 1893, gives to that Court jurisdiction of appeals from final decisions of the Commissioner of Patents both in ex parte cases and in interference cases.

Where an appeal of either class is to be prosecuted to the Court of Appeals of the District of Columbia the first step is to file with the Commissioner of Patents a notice of appeal, together with an assignment of reasons of appeal. This step must be taken within forty days, exclusive of Sundays and legal holidays, from the date of the decision of the Commissioner of Patents sought to be reviewed.

The next step in the prosecution of such an appeal is to file with the clerk of the Court of Appeals of the District of Columbia a certified transcript of the record and proceedings in the Patent Office relating to the case in question, together with a petition for appeal, addressed to the Court of Appeals of the District of Columbia, make a deposit of $15, and have the appearance of a member of the bar of that Court entered for the appellant.

The notice of appeal and reasons of appeal required to be served upon the Commissioner of Patents may be signed by the applicant or by his attorney of record in the Patent Office, but the petition for an appeal that is filed in the Court of Appeals of the District of Columbia must be signed by a member of the bar of the Court of Appeals of the District of Columbia, who should enter a regular appearance in the case in the clerk's office.

After the petition for appeal, the certified transcript, and the docket fee of $15 have been lodged in the office of the clerk of the Court of Appeals of the District of Columbia, the clerk will send to the solicitor of record an estimate of the cost of printing the petition, transcript, etc.

When the amount called for is deposited, the clerk will cause the printing to be done under his supervision, and when the printing is completed the case will be put on the calendar for hearing at the next term at which patent appeals are heard.

In interference cases the clerk is authorized to receive printed copies of the evidence, such as have been used in the Patent Office, thus saving to the appellant the cost of re-printing such evidence. When such printed copies are supplied, twenty-five copies must be furnished.

As above stated, the notice of appeal and the reasons of appeal are required to be filed with the Commissioner of Patents within forty days (exclusive of Sundays and legal holidays) of the date of the decision appealed from, but the petition for appeals and the certified transcript which are to be filed in the Court of Appeals of the District of Columbia are required to be filed in that Court within forty days (exclusive of Sundays and legal holidays) from the time of giving of the notice of appeal; that is to say, if the decision complained of was rendered for instance, on the 1st day of July, 1896, the party aggrieved might file his notice of appeal, with the reasons of appeal, at any time within forty days (exclusive of Sundays and legal holidays) thereafter; but if he filed his notice of appeal and reasons therefor on the 10th day of July, 1896, he would be required to file his petition for appeal and the certified transcript in the Court of Appeals of the District of Columbia within forty days (exclusive of Sundays and legal holidays) of the 10th of July, 1896.

Powers of the Court

ACT

SEC. 1. The "Act to establish a Court of Appeals for the District of Columbia, and for other purposes," approved February 9th, 1893 (27 Stats., 434, 436, ch. 74) as to Section 9 reads as follows:

> SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the General Term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eight of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals.

CONSTITUTIONALITY

SEC. 2. This act was held constitutional in United States, *ex rel.* Bernardin v. Duall, Commissioner of Patents, 86 O.G. 995.

CONSTRUCTION OF INTERFERENCE IN SECTION NINE OF ACT

SEC. 3. The word "interference" in section 9 of the act establishing the Court of Appeals of the District of Columbia interpreted and *Held* not to mean and include disputes in Trade-Marks under section 3 of the Trade-Mark law of 1881, but to be confined to an interference in patent law—Einstein v. Sawhill, 65 O.G. 1918.

RULES OF PATENT OFFICE RELATING TO APPEALS

RULE 148

SEC. 4. From the adverse decision of the Commissioner upon the claims of an application and in interference cases, an appeal may be taken to the Court of Appeals of the District of Columbia in the manner prescribed by the rules of that Court.

RULE 149

When an appeal is taken to the Court of appeals of the District of Columbia, the appellant will give notice thereof to the Commissioner, and file in the Patent Office, within forty days, exclusive of Sundays and holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing.

RULE 150

Pro forma proceedings will not be had in the Patent Office for the purpose of securing to applicants an appeal to the Court of Appeals of the District of Columbia.

RULE 8

COURT OF APPEALS OF THE DISTRICT OF COLUMBIA

It is ordered by the Court that the order of January 9, 1908, modifying Section 2, Rule 8, by limiting the time of argument to one hour on each side, be, and the same is hereby, suspended until further order.

Per MR. CHIEF JUSTICE SHEPARD

Feb. 2, 1909.

Test: HENRY W. HODGES,
Clerk of the Court of Appeals of the District of Columbia.

JURISDICTION

AS TO ITS SCOPE

SEC. 5. The jurisdiction of the Court of Appeals of the District of Columbia to entertain appeals from the decisions of the Commissioner of Patents in proceedings relating to patents is limited to two classes—(1) Where the claims of an application for a patent or the re-issue of a patent after having been twice rejected have been finally rejected on

appeal to the Commissioner in due course of proceeding. (2) Where an appeal to the Commissioner in an interference proceeding there has been a final decision on priority in favor of one of the parties thereto. R. S. Secs. 4909, 4910, 4911; Westinghouse v. Duncan, 2 App.D.C. 8, 17, 26; Union Distilling Co. v. Schneider, 29 App. D.C. 1; In re Fullager, 138 O.G. 259.

As To Appeal On A Motion To Dissolve

Sec. 6. The Court of Appeals of the District of Columbia has no jurisdiction to entertain an appeal from a decision of the Commissioner of Patents on a motion to dissolve an interference between an appellant for re-issue and an original application holding that appellant had no right to a re-issue on the ground that his showing of inadvertence, accident, or mistake was insufficient and that he had failed to excuse the long delay of more than two years in filing the re-issue application, as such judgment does not constitute an adjudication of the question of priority between the parties. In re Fullagar, 138 O.G. 259.

As To Administration Of Patent Office

Sec. 7. The Court has jurisdiction of appeals from the Commissioner of Patents in certain matters defined by statute, but has no original jurisdiction to direct and supervise the administration of the affairs of the Patent Office. A petition to direct the Commissioner to allow petitioner to proceed with the taking of testimony refused. DeFerranti v. Lindmark 137 O.G. 733, Neill v. Commissioner of Patents 82 O.G. 749.

As To Remedy In Equity

Sec. 8. The Act establishing the Court of Appeals did not by implication repeal the Statute providing remedy by bill in equity in a circuit court. Bernardin v. Vorthall and Seymour, Commissioner of Patents 78 O.G. 1740.

Appeal

PARTIES

As To Appeal

Sec. 9. A motion by E. that he be made a party to an appeal to the Court of Appeals of the District of Columbia taken by F. from a decision of the Commissioner of Patents on a motion to dissolve holding that F. had no right to make the claims of the issue because of his delay in filing his re-issue application involved in this interference denied on the ground that the Commissioner's decision did not result in award of priority to E., and therefore F. could not bring him before the Court by an appeal. For

the same reasons E.'s motions to have the docket entry changed and to dismiss F.'s appeal denied. In re Fullagar, 138 O.G. 259.

As To Rights Respecting Non-Appealing Parties

Sec. 10. Where an interference is declared between three parties and all present testified and but one of the parties takes an appeal to the Court of Appeals, the case made out by the party who has not appealed cannot be considered in the determination of the controversy. Richard v. Meissner, 114 O.G. 1831.

FINAL DECISIONS OF COMMISSIONER

As To Final Decisions

Sec. 11. Up to the present time the Court of Appeals has entertained appeals in interference cases only from the final decision of the Commissioner upon the question of priority of invention. (Allen, Commissioner of Patents, v. The United States of America, *ex rel.*, Lowry and Planter Compress Co., 116 O.G. 2253.) DeFerranti v. Lindmark, 137 O.G. 731; Marshutz v. Commissioner of Patents, 85 O.G. 778.

As To Certain Cases

Sec. 12. The statutes give right of appeal only in cases where the various tribunals of the Office acted and not when the Examiners-in-Chief suggest that the issue is not patentable. Serrell v. Donnelly, 129 O.G. 2501.

As To Amendments

Sec. 13. Neither the rules of this Court, nor of the Patent Office, mention amendments as the reason of appeals; but when made in due time, to correct an assignment that may not be sufficiently specific, or some inadvertance in its preparation, and no possible injury could be done to the opposing party, we see no reason why it should not be permitted. Horine v. Wende, 129 O.G. 2858.

SUBJECT-MATTER

As To Patentability In Interference Cases

Sec. 14. In general, the question of patentability is not open in an appeal in interference cases. (Hisey v. Peter, 71 O.G. 892; Doyle v. McRoberts, 79 O.G. 1029.) Orcutt v. McDonald, Jr., and McDonald, 123 O.G. 1288; Newton v. Woodward, 93 O.G. 2320 (explaining Bechman v. Wood, 89 O.G. 2320); Latham v. Armat, 95 O.G. 232. (See subject "Patentability" in section 6.) Potter v. McIntosh, 127 O.G. 1995; Mill v. Midgley, 136 O.G. 1534; Luger v. Browning, 104 O.G. 112. (Distinguishing from Oliver v. Felbel, 100 O.G. 2384); Dodge v. Fowler, 82 O.G. 595; Doyle v. McRoberts, 79 O.G. 1529.

As To Priority Being Settled Before Patentability

Sec. 15. The Court of Appeals regards it as improper for them to adjudicate the question of priority before the question of patentability is fully settled. Slaughter v. Halle, 102 O.G. 469.

As To Interlocutory Rulings

Sec. 16. It is well settled that this Court cannot and should not interfere with such (interlocutory) rulings, unless perhaps in extreme cases it should be necessary for the maintenance of the jurisdiction of this Court. Ritter v. Krakau & Connor, Jr., 114 O.G. 1553-1554.

As To Newly Discovered Evidence

Sec. 17. The re-opening of a case for the introduction of newly discovered evidence is a matter of discretion for the trial court, and will not be reviewed by this Court. Richards v. Meissner, 114 O.G. 1831; Dunbar v. Schellenger, 128 O.G. 2837; Omes v. Starr, 117 O.G. 1495.

As To Interlocutory Decisions Not Subject To Reviews

Sec. 18. The decision was an interlocutory one relating to the general practice of the Office (Rules 30, 31, 75) in all such cases, and the question of its propriety as presented, is not necessarily involved in the decision on its merits. For the reasons given in the following cases it is not the subject of review: Westinghouse v. Duncan, 66 O.G. 1009; Mill, 11 App. D.C. 584, 588; Frasch, 100 O.G. 1977; 192 U.S. 566; Davis v. Garrett, 123 O.G. 1991; Hulett v. Long, 89 O. G. 1141.

As To Descriptions Not Usually Reviewable

Sec. 19. The question whether the description in a design case is a proper one is not reviewable by the Court of Appeals except in an extraordinary case. Mygatt, 121 O.G. 1676.

As To Trade-Mark Interference

Sec. 20. A trade-mark interference declared under the act of 1881 but not decided until after the passage of the act of February 20, 1905, is appealable to the Court of Appeals of the District of Columbia under the act of February 20, 1905, where the only application involved has been amended to bring it under the provision of that act. Giles Remedy Company v. Giles, 120 O.G. 826.

As To Priority Of Invention

Sec. 21. A decision against a party on the ground that his original application did not contain the inventions seems to be one of priority of invention and the decision should be such as to give the unsuccessful party opportunity to take an appeal in the interference to the Court of Appeals and not one dissolving the interference. Pohle v. McKnight, 119 O.G. 2519.

As To Identity Of Invention

Sec. 22. Question of the identity of the inventions involved proper to be considered by the Court of Appeals on appeal from the final decision of the Commissioner. Bechman v. Wood, 89 O.G. 2459; but see Bechman v. Wood, 89 O.G. 2462.

As To Quasi-Judicial Proceedings

Sec. 23. It is only by regarding the proceedings in the Patent Office as quasi-judicial in their nature that the validity of the legislation which authorizes appeals to the Court of Appeals from the decision of the Commissioner of Patents can be sustained. Barratt v. Duall, Commissioner of Patents, 87 O.G. 1075.

As To Refusal To Consider Patentability Final

Sec. 24. A refusal to consider patentability in cases of priority does not establish the conclusion that the decision of the Commissioner upon questions of patentability in such cases is final and conclusive. Such questions should come before the Court by regular course of appeal. Breul v. Smith, 79 O.G. 153.

As To Certain Rights Of Party Considered Ancillary

Sec. 25. The right of a party to make a claim will be considered as an ancillary question to be considered in awarding priority of invention. United States of America, *ex rel.*, The Newcomb Motor Company v. Moore Co., 133 O.G. 1680.

As To Decisions Confined To Matters Considered By Commissioner

Sec. 26. The Court will confine its decision to the matter passed upon by the Commissioner and not consider the question of abandonment, prior public cases, and anticipation of the invention which have not been acted on in the Patent Office. Colhoun v. Hodgson, 70 O.G. 276; Cutler v. Leonard, 136 O.G. 438.

As To Additional Claim Presented

Sec. 27. Whatever practice should have been pursued in regard to the additional claim presented for the first time to the Commissioner in person which was neither considered nor rejected, we do not consider that we are at liberty to pass upon it on this appeal. Garrett, 122 O.G. 1047.

As To Claim Considered By The Office

Sec. 28. Only claims considered by the Office will be considered by the Court on appeal. As to bill in equity see Durhamy v. Seymour, Commissioner of Patents, 71 O.G. 601; and the construction given by the Office adhered to. Breul v. Smith, 78 O.G. 1906.

As To Distinction Between Rights Of Appeal And Refusal Of Patent

Sec. 29. The right of appeal in case of the refusal of a patent upon

the ground of non-patentability of the claim, and refusal of a patent because of interference with a prior right of invention, are distinct rights. The latter does not involve the former. This is clearly indicated in the Revised Statutes of the United States section 4911, and in section 9 of the act of Congress of February 9, 1893, providing for the organization of this Court. Hisey v. Peters, 71 O.G. 892.

As To Patentability Not Re-Considered

Sec. 30. The Court will not consider the question of patentability a second time in a new application for the same subject matter. Barratt v. Duall, Commissioner of Patents, 87 O.G. 1075.

As To Consideration Of Final Decisions

Sec. 31. Only appeals from final decisions considered. Cross v. Phillips, 87 O.G. 1399; Hulett v. Long, 89 O.G. 1141; Westinghouse, Jr., v. Duncan, 66 O.G. 1009.

MOTIONS

As To Delay

Sec. 32. A motion to dismiss an appeal on the ground that it was taken in bad faith for the purpose of delay will not be postponed to the final hearing if a *prima facie* case is made out. Jones v. Starr, 117 O.G. 1495.

As To Appellee's Right To Have Cause Dismissed

Sec. 33. The appellant having failed to have his cause filed and docketed, on motion of the appellee the cause was docketed and dismissed. Cleaveland v. Wright, 79 O.G. 886; Southall v. Seymour, Com., 79 O.G. 1684; McCreary v. Seymour, Com., 79 O.G. 1684; Morrissey v. Seymour, Com., 79 O.G. 1684.

As To New Trial

Sec. 34. Court will entertain a motion for a new trial pending an appeal. Practice, Clement v. Richards v. Meissner, 111 O.G. 1627.

ORDER

As To Refusing New Trial

Sec. 35. No appeal from orders refusing a new trial or rehearing. Greenwood v. Dover, 109 O.G. 2172; Messinger v. Commissioner of Patents, 83 O.G. 1995.

RECORD

As To Content

Sec. 36. Confined to the record made up in the Office. Heroult, 127 O.G. 3217.

As To Failure To Print

Sec. 37. Failure to print transcript of record is ground under Court Rule for dismissing appeal. Munson v. Carper, 79 O.G. 160; Pelton v. Evered, 77 O.G. 16.

As To Being Public

Sec. 38. The record of the proceedings in the Patent Office upon being filed with the clerk of the Court of Appeals becomes a public record. Drawbaugh, 66 O.G. 1451.

RULES

As To Limitation Of Time

Sec. 39. The Court of Appeals was duly authorized by statute to make rules limiting the time of appeal from the decisions of the Commissioner of Patents. 77 O.G. 507.

WEIGHT GIVEN COMMISSIONER'S DECISIONS

As To The Rule Of The Conclusiveness Of Facts

Sec. 40. On questions of fact the concurrent decisions of the lower tribunals will be taken as conclusive, unless the contrary is clear.

Cases Reviewed

Sec. 41. Arnold v. Tyler, 79 O.G. 156; Hisey v. Peters, 71 O.G. 892; Hien v. Buhoup, 81 O.G. 2088.

Conception

Sec. 42. Ball v. Flora, 121 O.G. 2668.

Diligence

Sec. 43. O'Connell v. Schmidt, 122 O.G. 2065; Park v. Lewis, O.G. 2313.

Disclosure

Sec. 44. Ostergren v. Tripler, 95 O.G. 837; Schiipphaus v. Stevens, 95 O.G. 1452; Austin v. Johnson, 95 O.G. 2685; Kilbourn v. Hirner, 128 O.G. 1689.

Employer & Employee

Sec. 45. Orcutt v. McDonald, Jr., and McDonald, 23 O.G. 1287; Ries v. Kirkgaurd and Jehsen, 132 O.G. 845.

Evidence

Sec. 46. Baur v. Crone, 120 O.G. 1824; Bourn v. Hill, Jr., 123 O.G. 1284.

Identity Of Invention

Sec. 47. Bechman v. Southgate, 127 O.G. 1254; Herman v. Fullman, 109 O.G. 1888. But see Beals v. Finkerhiner, 82 O.G. 598.

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Sec. 48. Ritter v. Krakau and Connor, Jr., 114 O. G. 1553; Rosell v. Allen, 92 O.G. 1036.

Operativeness

Sec. 49. Stone v. Pupin, 100 O.G. 114; Duryea and White v. Rice, Jr., 126 O.G. 1357.

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Sec. 50. Murphy v. Meissner, 114 O.G. 592; Cleveland v. Wilkins, 123 O.G. 1286.

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Sec. 51. Weber v. Barry, Jr., 117 O.G. 1494; Seeberger v. Dodge, 114 O.G. 2382; Beswick v. Commissioner, 91 O.G. 1437; Latham v. Armat, 95 O.G. 232; Munster v. Ashworth, 28 O.G. 2088; Clunies, 123 O.G. 2361; Adams, 114 O.G. 2093; Dunbar v. Schellenger, 128 O.G. 2837. (See also section 11 under "Subject Matter.")

Priority

Sec. 52. Clenn v. Adams, 83 O.G. 158.

Reduction To Practice

Sec. 53. Howard v. Hey, 95 O.G. 1647; Flora v. Powrie, 109 O.G. 2668; Esty v. Newton, 86 O.G. 799; Munster v. Ashworth, 128 O.G. 2088; Richards v. Burkholder, 128 O.G. 2533; Wickers and Furlong v. McKee, 129 O.G. 869.

As To Construction Of Rule

Sec. 54. The rule that the concurrent decisions of the Office as to facts will be followed, except in a clear case, does not mean that the Court will be bound by the conclusions from such facts. O'Connell v. Schmidt, 122 O.G. 2065; Orcutt v. McDonald, Jr., and McDonald, 123 O.G. 705.

As To Circumstances When Rule Is Followed

Sec. 55. The rule that concurrent decisions in the Patent Office will be followed, is especially applicable in a case which involves complicated constructions about which the experts of the Patent Office are less liable

to err than ourselves. Lindmark v. Hodgkinson, 137 O.G. 228; Seeberger v. Dodge, 114 O.G. 2382.

As To Conclusions By Different Paths

Sec. 56. That these tribunals have reached their conclusions by different paths does not detract from the weight to be given to their decisions. Bourn v. Hill, Jr., 123 O.G. 1284.

As To Reversability Of Erroneous Conclusions

Sec. 57. Where the facts are admitted and a mere question of law is involved, the Court will not hesitate to reverse the judgment appealed from if convinced that an erroneous conclusion was reached. Woods v. Poor, 130 O.G. 1313.

Mandamus

As To Time Limit

Sec. 58. Where a party delays beyond the time limited to take his appeal, mandamus will not lie to the Supreme Court to compel the Court of Appeals to entertain the appeal. Hein, 79 O.G. 507.

As To Not Being The Remedy

Sec. 59. A mandamus to compel the Court of Appeals to hear appeal from Commissioner on question of division not the remedy. It should be to the Examiners-in-Chief in the first place. Frasch, 109 O.G. 554.

As To Remedy To Alternate With Appeal

Sec. 60. Mandamus is not alterante remedy with appeal. United States, *ex rel.*, Tuttle v. Allen, Commissioner of Patents, 126 O.G. 760.

As The Remedy

Sec. 61. Mandamus to the Commissioner on appeal to the Court, the remedy where an appeal to the Board is denied. Frasch, 109 O.G. 554. No appeal as to the division of an application. Frasch, 100 O.G. 1977.

As To Remedy Being Final In Court Of Appeals

Sec. 62. No appeal can be taken to the Supreme Court of the United States from a decision of the Court of Appeals refusing a mandamus to compel the Commissioner to register a trade-mark. The United States, *ex rel.*, the State of South Carolina v. Seymour, Commissioner, 67 O.G. 1191.

Effect of the Decision of the Court On the Commissioner

As To Decisions Of The Court Binding

Sec. 63. The Commissioner is bound to follow the decision above upon those points only which were raised by the appeal, and upon no other. It is for a judge to say that a decision of the Commissioner shall be affirmed or reversed, not to say that a patent shall or shall not issue. Abraham v. Fletcher, 69 C. D. 50.

As To Finding Of Facts Of The Court Binding On Commissioner

Sec. 64. The Office is bound to take notice of the decision of the Court and may base its action upon the finding of facts contained therein. Tournier, 108 O.G. 798.

As To Dissolution

Sec. 65. After a decision by the Court of Appeals it is too late to dissolve for lack of interference in fact. Gilbart, 85 O.G. 454.

As To Rehearing Concerning Priority

Sec. 66. It is conceivable that a case might arise where the Commissioner might grant a rehearing after a decision by the Court of Appeals on the question of priority. Scott v. Brooks, 71 O.G. 1314.

As To Case Re-Opened Under Unusual Circumstances

Sec. 67. After an appeal to the Court of Appeals refusing the allowances of certain claims, a case will not be re-opened for the consideration of additional claims except under unusual circumstances. That the Court put an interpretation on the claims not contemplated by applicant not sufficient. Milans, 135 O.G. 1122.

As To Refusal Of Patent After Appeal On Priority

Sec. 68. After an appeal on the question of priority, the Commissioner may refuse a patent to the successful party. Sobey v. Holsclaw, 126 O.G. 3041.

Time Limit Rules

As To Limitation Of Time For Appeal

Sec. 69. This rule limits the time in which the appeal must be taken to forty days from the date of the order appealed from ,excluding the day of date. Burton v. Bentley, 87 O.G. 2326.

As To No Extention Of Time

Sec. 70. The Office has no power to extend time. Clement v. Richards v. Meissner, 111 O.G. 1626-7.

As To Computing Legal Holidays

Sec. 71. Saturday after 12 o'clock is a legal holiday and is to be computed as one half day. Ocumpaugh v. Norton, 114 O.G. 545.

As To Exception

Sec. 72. A party allowed to prosecute his appeal when notice was filed one day late. Proutt v. Johnston and Johnston, 130 O.G. 2118.

As To Forty Days Rule

Sec. 73. The rule that all appeals taken from the Commissioner of Patents shall be taken within 40 days from the date of the ruling and not afterward is a positive law to the Court and to the suitors therein. Ross v. Soewer, 77 O.G. 2141; Bryant v. Seymour, Com. of Patents, 77 O.G. 1599.

As To Commencement Of Action

Sec. 74. The two years allowed for an action by R. S. 4894 is not applicable to appeals to the Court of Appeals. 77 O.G. 1600.

As To New Trial

Sec. 75. The running of the time limited for appeal is not arrested by a motion for a new trial. Ross v. Soewer, 77 O.G. 2141.

As To Lapse Of Time In Rehearing

Sec. 76. Whenever the time for appeal has gone by the time for rehearing has elapsed with it. Scott v. Brooks, 71 O.G. 1314.

Miscellaneous

As To Court's Control Of Assignment

Sec. 77. The Court cannot control the description of the Commissioner as to the length of argument he should permit. Sobey v. Holsclaw, 126 O.G. 3041.

As To Court Being Powerless To Direct Action Of Executive Officer

Sec. 78. The Court is powerless to direct the action of an executive officer unless a positive legal right is being invaded by the officer where the duty imposed upon him is clearly prescribed and enjoined by law. The duty, however, must be so plain and pointed that the officer has no

discretion left. (Merriel on Mandamus, p. 64.) Moore, Com. of Pats., v. U. S. *ex rel.*, Boyer, 138 O.G. 530.

As To Court's Allowance Of Writ Of Error Or Appeal

Sec. 79. Neither writ of error or appeal will be allowed by this Court. Decision not to prejudice an application to any one of the justices of the Supreme Court. Rousseau v. Brown, 104 O.G. 1122.

As To Court's Acceptance Of Commissioner's Decision

Sec. 80. The two lower tribunals of the Office held that the inventions were the same, and the Commissioner that they were different, the theory of the Commissioner accepted without enquiry. Cushman v. Lines, 78 O.G. 2051.

As To Court's Discretion To Relieve Against Default

Sec. 81. Judgment in an interference proceeding will not be made final by the Office after the filing of a notice of appeal, on the ground that it was filed one day late, it being regarded as being within the discretion of the Court to relieve against the default. Proutt v. Johnston and Johnston, 130 O.G. 2718.

As To Court's Power To Award Costs

Sec. 82. The Court has no power to award costs. Wells v. Reynolds, 69 O.G. 1507.

As To Where Record Has No Bearing In Case

Sec. 83. When a record was introduced, but on an examination found to have no bearing in the case, it must be at the cost of the one offering it. Stevens v. Seher, 81 O.G. 1932.

As To Res Adjudicata Based On General Assignment Of Error

Sec. 84. A general assignment of error in appeal from the Examiner to the Board is sufficient to base the question of *res adjudicata* upon, or it might have been raised by the Board on its own motion. Carroll v. Hallwood, 135 O.G. 896.

As To Presumption Of Acquiesence In Decision

Sec. 85. B. has appealed but his assignment of errors does not challenge the decision of the Commissioner on the question of priority of invention "and to this extent he is presumed to have asquiesed in the decision against him." Bechman v. Wood, 15 App.D.C. 487.

As To Patentability Being Reserved

Sec. 86. (In an interference case) "The present is no more than a moot cause since upon the face of the record itself the question of patentability has been expressly reserved for further and future consideration." Oliver v. Felbel, 100 O.G. 2384.

As To Time Allowance Not Prejudicial

Sec. 87. A party may take advantage of all the time allowed by law without prejudicing his case. Jones v. Starr, 117 O.G. 1495.

As To Assignment Of Trade-Mark

Sec. 88. An assignment of a trade-mark permitted after notice and before appeal is perfected. Levy & Co. v. Uri, 131 O.G. 1689.

As To Consideration Of Affidavit Concerning Changes In Drawing

Sec. 89. We will not consider affidavits filed either in this Court or the Patent Office relating to changes that have occurred in drawings, models, experimental machines and like exhibits. These matters must be wholly settled in the Patent Office. (Blackford v. Wilder, 104 O.G. 580.) Greenwood v. Dover, 109 O.G. 2173; Willsin v. Bradshaw, 91 O.G. 648.

As To Verification By Attorney

Sec. 90. Affidavit verified before notary who was also attorney in the case is invalid. The prohibition of attorneys acting as notaries in the Code of the District applies to attorneys outside of the District. The Hall Safe Co. v. Herring-Hall-Marvin Safe Co., 135 O.G. 1804.

As To Preliminary Statement

Sec. 91. Appeal from a decision upon the right to amend preliminary statement. Cross v. Phillips, 87 O.G. 1399.

PATENT CITATOR

FOR

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